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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,158	03/25/2004	Pelegrin Torres JR.	PD-203061	7382
20991 7590 06/26/2007 THE DIRECTV GROUP INC PATENT DOCKET ADMINISTRATION RE/R11/A109 P O BOX 956 EL SEGUNDO, CA 90245-0956			EXAMINER SIPOS, JOHN	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 06/26/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/809,158

Applicant(s)

TORRES, PELEGRIN

Examiner

John Sipos

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8 and 10-37 is/are pending in the application.
- 4a) Of the above claim(s) 14-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10-13,36 and 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### ***DETAILED ACTION***

Claims 1,3-8,10-13 and 36-37 are pending in the application with claims 14-35 having been withdrawn from further prosecution and claims 2 and 9 having been cancelled.

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### ***REJECTIONS OF CLAIMS BASED ON PRIOR ART***

**Claims 1,3-9,11-13,36 and 37** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Limelette (6,899,276) and further in view of Adelman (4,601,157). The APA comprises the placing of a Smart Card having a bar code in an envelope that is preprinted with a license agreement and then sealing the envelope. The envelope has a window that makes the bar code visible without opening the envelope. The opening of the preprinted envelope indicates acceptance of the agreement by the customer. This APA lacks the use of a film for the packaging and the treatment of the film material with antistatic material. The patent to Limelette shows the wrapping of a data-encoded card in a polypropylene film that comprises a window portion to provide visibility of the card. In view of the teaching of Limelette it would have been obvious to one skilled in the art to use a film to package the Smart Card of the APA instead of the paper envelope to form a cheaper and a more easily mass-produced package.

The patent to Adelman teaches that treatment of the wrapping material against static electricity to pack articles with printed circuit boards (column 1, lines 30-40). It would have been obvious to one skilled in the art to treat the material of APA against

static electricity when packing an article that is sensitive to static electricity as taught by Adelman.

The handling of integrated circuit chips and printed circuit board that are known to be "fragile" and "sensitive to bending scratching and static electricity" (see page 1 of the instant specification) without contacting the sensitive portions would have been obvious to any person handling such sensitive boards. Such contact and damage would defeat the purpose of the whole protective packaging operation.

The specific thickness of the packaging material and size of the licensing agreement relative the card and the film (claims 4,5 and 13) are matters of experimentation as to the most cost effective and optimum package. For example, the reducing the size of a package lowers the cost of the packaging material. Since the use of license agreement on the exterior of a package is known (as taught by the APA) and since the use of exterior printing on both the front and back of packages are known as well (e.g. compact disk packages, books), it would have been obvious to one skilled in the art to continue the license agreement printed on the front of a package on the back of the package if it is longer than the dimensions of the package.

The use of magazine to hold a plurality of cards and to feed them one at a time to the processing station (claims 9 and 36) is well known in the art and the Examiner takes official notice that its use is common knowledge in the packaging art. The modification of the APA operation would have been obvious to one skilled in the art for the known benefits of the modification. For example, feeding cards out of a magazine increases

the efficiency of the operation and the use of anti static means reduces damage to cards carrying data chips.

Regarding claim 11, the printing of dark text against light background regardless of the material is well known in the packaging art and one such example is the APA envelope and using the same concept on a film would have been obvious to one skilled in the art to make the print more legible.

The specific type of a card and the contents of the card (claims 13 and 36) are matter of little patentable significance since the packaging process of the applied references can be performed with any flat Smart Card.

**Claim 10 is rejected under 35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Limelette (6,899,276) and Adelman (4,601,157). and in view of the Admitted Prior Art 2 (APA2).

As was stated in the last Office action, the examiner considers the use of spines on packages well known and took Official Notice of such use. Therefore, it would have been obvious to one skilled in the art to provide the Smart Card package with a spine to provide for easier access and grasping of the package. In view of these assertions made by the Examiner in the last Office action and Applicants silence regarding them, the motion sensor feature is considered as an admission of prior art.

**Claims 1,2-9, 11-13,36 and 37** are rejected under **35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Roshkoff (6,042,149) and further in view of Adelman (4,601,157) or

alternatively, Roshkoff (6,042,149) in view of Admitted Prior Art (APA) of pages 1-3 of the instant specification and further in view of Adelman (4,601,157).

The APA comprises the placing of a Smart Card having a bar code in an envelope that is preprinted with a license agreement and then sealing the envelope. The envelope has a window that makes the bar code visible without opening the envelope. The opening of the preprinted envelope indicates acceptance of the agreement by the customer. This APA lacks the use of a film for the packaging and the treatment of the film material with antistatic material.

The patent to Roshkoff shows the wrapping of a Smart Card 18 in transparent plastic film 10 that provides visibility of bar code printed on the Smart Card and with the exterior surface of the film 14 carrying printed matter.

In view of the teaching of Roshkoff it would have been obvious to one skilled in the art to use a film to package the Smart Card of the APA instead of the paper envelope to form a cheaper and a more easily mass-produced package.

Alternatively, it would have been obvious to one skilled in the art to print a license agreement on the exterior surface of the film of Roshkoff as taught by APA which would minimize the cost of using extra materials in the package.

The patent to Adelman teaches that treatment of the wrapping material against static electricity to pack articles with printed circuit boards (column 1, lines 30-40). It would have been obvious to one skilled in the art to treat the material of APA or Roshkoff against static electricity when packing an article that is sensitive to static electricity as taught by Adelman.

The handling of integrated circuit chips and printed circuit board that are known to be "fragile" and "sensitive to bending scratching and static electricity" (see page 1 of the instant specification) without contacting the sensitive portions would have been obvious to any person handling such sensitive boards. Such contact and damage would defeat the purpose of the whole protective packaging operation.

The specific thickness of the packaging material and the size of the licensing agreement relative the card and the film (claims 4,5 and 13) are matters of experimentation as to the most cost effective and optimum package. For example, the reducing the size of a package lowers the cost of the packaging material. Since the use of license agreement on the exterior of a package is known (as taught by the APA) and since the use of exterior printing on both the front and back of packages are known as well (e.g. compact disk packages, books), it would have been obvious to one skilled in the art to continue the license agreement printed on the front of a package on the back of the package if it is longer than the dimensions of the package.

Regarding claims 6 and 7, since the Roshkoff package uses transparent film through which the bar code is visible, the "window" of these claims is read on the transparent nature of the film.

The use of windows in packages to permit visibility of indicia such as bar codes (claim 8), the use of a magazine to hold a plurality of cards and to feed them one at a time to the processing station (claims 9 and 36) are well known in the art and the Examiner takes official notice that their use is common knowledge in the packaging art. In the above cases the modification of the APA operation would have been obvious to

one skilled in the art for the known benefits of each modification. For example, windows permit the visibility of only portions of the contents and feeding cards out of a magazine increases the efficiency of the operation.

Regarding claim 11, the printing of dark text against light background regardless of the material is well known in the packaging art and one such example is the APA envelope and using the same concept on a film would have been obvious to one skilled in the art to make the print more legible.

The specific type of a card and the contents of the card (claims 13 and 36) are matter of little patentable significance since the packaging process of the applied references can be performed with any flat Smart Card.

**Claim 10 is rejected under 35 U.S.C. ' 103(a)** as being unpatentable over Admitted Prior Art (APA) of pages 1-3 of the instant specification in view of the patent to Roshkoff (6,042,149) and Adelman (4,601,157) or alternatively, Roshkoff (6,042,149) in view of Admitted Prior Art (APA) of pages 1-3 of the instant specification and Adelman (4,601,157) and further in view of the Admitted Prior Art 2 (APA2).

As was stated in the last Office action, the examiner considers the use of spines on packages well known and took Official Notice of such use. Therefore, it would have been obvious to one skilled in the art to provide the Smart Card package with a spine to provide for easier access and grasping of the package. In view of these assertions made by the Examiner in the last Office action and Applicants silence regarding them, the motion sensor feature is considered as an admission of prior art.

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### ***ADDITIONAL REFERENCES***

The patents to Hamer, Nishimura and Stahl show the use of anti-static materials or treatments to protect sensitive articles with Stahl using anti-static bars 21.

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### ***RESPONSE TO APPLICAN'S ARGUMENTS***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. It should however be noted that the careful handling of sensitive printed circuit boards by using an antistatic materials or mechanism with the packaging material is an obvious and a necessary part of the packaging operation. Similarly, the avoidance of contact with the sensitive circuit boards is also obvious and necessary for the proper packaging of such items.

The claims are directed to packaging data-encoded card in films and the patents to Limlett and Roshkoff show that concept with the other references showing the secondary concepts of using licensing agreements and anti-static materials with such sensitive articles..

Regarding the submitted Affidavit, it seems to refer only to the system described in the above referenced application and not to the individual claims of the application. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716.

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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

3706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Any inquiry concerning this communication should be directed to **Examiner John Sipos** at telephone number **571-272-4668**. The examiner can normally be reached from 6:30 AM to 4:00 PM Monday through Thursday.

The **FAX** number for U.S. Patent and Trademark Office is **(571) 273-8300**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at **571-272-4467**.

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**John Sipos**  
**Primary Examiner**  
**Art Unit 3721**